

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

|                          |   |                           |
|--------------------------|---|---------------------------|
| In re Application of:    | ) | Art Unit:                 |
|                          | ) |                           |
| KOPCHICK, et al.         | ) | Examiner:                 |
|                          | ) |                           |
| Serial No.: 10/552,443   | ) | Washington, D.C.          |
|                          | ) |                           |
| Filed: August 16, 2006   | ) | October 31, 2007          |
|                          | ) |                           |
| For: DIAGNOSIS OF HYPER- | ) | Docket No.: KOPCHICK=6.1A |
| INSULINEMIA AND TYPE II  | ) |                           |
| DIABETES AND...          | ) | Confirmation No.: 7248    |

REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND  
CHANGE OF CORRESPONDENCE ADDRESS PURSUANT TO  
37 CFR 1.36(b) AND 10.40(c)

U.S. Patent and Trademark Office  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

S i r :

Pursuant to 37 CFR 1.36(b) and 10.40(c), please withdraw me, and all attorneys and agents of record or associated with customer number 001444, as attorneys or agents for the above-identified application.

1. The reasons for the request are:

1.1. Implied Consent Under 37 CFR 10.40(c)(5). Client Ohio University has knowingly and freely assented to termination of the employment. Ohio University is a state University, and Counsel is formally retained by the Attorney General of the State of Ohio, to represent OU as a "Special Counsel". Article VII, Section 7, clause A of the Retention Agreement<sup>1</sup> permits "special counsel" to withdraw from representation on thirty days notice. Notice was given on October 15, effective November 30, which is

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<sup>1</sup> The last signed retention agreement was the FY 2007 retention agreement. Counsel has refused to sign the FY2008 retention agreement for various reasons, including those set forth in sections 2 and 3 below. However, the FY2008 retention agreement, drafted by the Office of the Attorney General of the State of Ohio, contains an identical withdrawal provision, so the client clearly consents to withdrawal under such circumstances.

more than thirty days notice. Hence withdrawal is proper if effective on November 30, or such later date as may be approved by the PTO.

1.2. Failure to Timely Pay Bills Under 37 CFR 10.40(c)(1)(vi). Client Ohio University has failed to pay one or more bills, rendered by the practitioner, for an unreasonable period of time<sup>2</sup>. According to our records, over \$100,000 in unpaid bills were billed over 180 days ago, and the oldest unpaid bills are dated February 7, 2006.

1.3. Irreconcilable differences under 37 CFR 10.40(c). There are also irreconcilable differences between Practitioner and Client as to future terms of employment.

In particular, the Attorney General of the State of Ohio, on behalf of client Ohio University, has refused to grant Counsel a fee increase (from a discounted rate set in 2001) which was timely requested on January 17, 2007 and again on April 5, 2007. Even with this increase, Counsel's rate for client would still be less than his current standard rate.

It is respectfully suggested, in good faith, that this qualifies as "other good cause for withdrawal" per 10.40(c)(6) and is "conduct which makes it unreasonably difficult for practitioner to carry out the employment effectively", per 10.40(c)(1)(iv).

2. The declaration executed by inventors Boyce and Kriete instructed us to take instructions in this case from Ohio University ("EDIS" is our client code for Ohio University).

Inventors Boyce and Kriete have assigned their rights to their former employer Icoria, Inc.

We do not have an attorney-client relationship with Icoria, Inc. (or with inventors Boyce and Kriete). They have not asked us to act as their attorney, they have never instructed as to

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<sup>2</sup> These unpaid bills were not necessarily specific to this case. As we understand 37 CFR 10.40(c)(1)(vi), it is triggered by failure to timely pay any bills rendered by the practitioner, not just bills for work in the case from which withdrawal is sought.

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actions to take in this case, they have not been billed by us or paid any of our bills, and in general is has acted as though Ohio University has control of prosecution. Other than obtaining execution of the necessary declarations and assignments, we merely copy Icoria on certain correspondence in this case.

Nonetheless, on October 16, 2007, we gave Icoria notice of our withdrawal from representation of Ohio University and invited them to notify us that week if it thought differently. They have not expressed any disagreement.

3. Effective on approval of this request, please change the correspondence address for this case and direct all further correspondence to:

Robert Malott  
Ohio University  
Technology Transfer Office  
340 West State Street - Unit 14  
Athens, OH 45701

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.  
Attorneys for Applicant

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